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10/765,781

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AB-1146 US

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7590 05/02/2007
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| EXAMINER |
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CASTELLANO, STEPHEN J

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| ART UNIT | PAPER NUMBER |
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3781

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/765,781

Applicant(s)

NAKAMURA ET AL.

Examiner

Stephen J. Castellano

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 27 March 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 11-13 and 18-20 is/are pending in the application.
- 4a) Of the above claim(s) 19 and 20 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 11-13 and 18-20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claim(s) 11-13 and 18-20 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date 3-26-07.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

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Claims 1-10 and 14-17 are canceled. Claims 11-13 and 18-20 are pending.

Newly submitted claims 19 and 20 are directed to an invention that is independent or distinct from the invention originally claimed for the following reasons: The species of Fig. 8 had not been originally presented and claims 19 and 20 are withdrawn as being directed to another species that was not elected.

Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claims 19 and 20 have been withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

Independent claims 11 and 18 both contain the limitation “an annular abutting surface defined by said first and second parts disposed concentrically one next to the other.” This phrase is interpreted to define a vertical surface by either the first or second part that abuts with the other part, respectively. See claim 11, lines 11 and 12 and claim 18, lines 12 and 13.

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 11-13, 19 and 20 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Claim 11 recites an annular abutting surface that is exposed (see line 14). There is no support in the originally filed application for an exposed abutting surface. There is

no support for an abutting surface that defines a concentric annular recess as recited in claims 19 and 20. **This is a new matter rejection.**

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 11-13 and 19 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 11 recites the limitation "said abutting surface of said first part" in line 14. There is insufficient antecedent basis for this limitation in the claim because the abutting surface was never stated as being a portion of the first part.

Also, line 14 of claim 11 describes the abutting surface as being exposed. An exposed surface would be required to be uncovered. An abutting surface is covered by any definition of the term "abutting" and therefore, the abutting surface is covered and can't be exposed. The exposed abutting surface contacts the outer layer of the fuel tank main body as stated in line 14-16 of claim 11, therefore, further confusing claim 11 as it can't be determined if the surface is exposed or covered, or covered by the other part or it contact and covered by the outer layer of the fuel tank main body.

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless—

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

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(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 11-13 are rejected under 35 U.S.C. 102 (e) as being anticipated by Nulman et al.

(Nulman).

Nulman discloses a component part (attachment or roll over valve 100) adapted to be fitted in an opening provided in the fuel tank (10), the fuel tank has a laminated design with outer HDPE (weldable plastic layer) layer (24) as shown in Fig. 1 and inner ethylene vinyl alcohol (EVOH) (fuel barrier) layer (18) as shown in Fig. 1, the fuel tank lamination is not believed to be different in Fig. 2 wherein the attachment (100) is shown, the attachment comprises a first part (104, 108) of gasoline barrier material made of acetal extending across the component part to substantially separate the interior from the exterior of the tank and a second part of high density polyethylene (HDPE) overmolding 116, 116a provided in a peripheral part of the component part which is welded to an outer layer of the tank surrounding the opening, the peripheral part defines an annular abutting surface (at for example point 122), the abutting surface is defined by the first and second parts disposed concentrically one next to the other, the second part at the abutting surface (122) projecting slightly beyond the first part at the abutting surface. Insofar as the abutting surface of the first part abuts the second part and that this abutting contact with the second part prevents the abutting surface from being exposed and from contacting the outer layer of the tank, the claim 11 limitations are met.

Re claim 12, the second part projecting beyond the first part at the abutting surface defines a convex surface (with conical portion 106) as the parts are circular in horizontal cross section.

Re claim 13, the second part projecting beyond the first part at the abutting surface defines a slanted flat surface as viewed in the vertical section of Fig. 2.

The following rejections are made insofar as the effective filing date of the present application is July 17, 2001 since (1) English language translations for the Japanese priority documents have not been provided in either application serial No. 10/765781 or 09/908271 and (2) those translations have not been certified.

Claims 11-13 are rejected under 35 U.S.C. 102(e) as being anticipated by Suzuki et al. (Suzuki)(October 13, 2000 filing date).

Suzuki discloses a laminated fuel tank (1) in combination with a component part (6) which meets all of the limitations of the claimed invention. Especially, the second part (flange portion 7) at the abutting surface projecting slightly beyond (in a radially outward direction) said first part (8, 8a) at said abutting surface and exposing said abutting surface (8a) of the first part so that this exposed abutting surface contacts the outer layer (4) of the tank main body when the second part is welded.

Please note that the limitations of claims 12 and 13 rely upon Japanese document 2000-394659 alone with a date of filing of December 26, 2000. Since the December 26, 2000 filing date doesn't precede the October 13, 2000 filing date, this foreign priority document doesn't adequately establish an earlier filing date even if the English language translation and certification are provided.

Claims 11-13 are rejected under 35 U.S.C. 102(a) as being anticipated by Japanese reference JP 2001-113963 to Suzuki et al. (Suzuki)(publication date April 24, 2001).

The disclosure of this Kokai reference is believed to be identical to Suzuki et al. (6305568). Suzuki discloses a laminated fuel tank (1) in combination with a component part (6) which meets all of the limitations of the claimed invention. Especially, the second part (flange portion 7) at the abutting surface projecting slightly beyond (in a radially outward direction) said first part (8, 8a) at said abutting surface and exposing said abutting surface (8a) of the first part so that this exposed abutting surface contacts the outer layer of the tank main body when the second part is welded.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 18 is rejected under 35 U.S.C. 103(a) as being unpatentable over Nulman or Suzuki (6305568) or Suzuki (JP 2001-113963) in view of Hyde et al. (Hyde)(5139043).

Nulman, Suzuki (6305568) and Suzuki (JP 2001-113963) all individually disclose the invention except for the first part being an outer layer. Hyde teaches a vapor vent valve which is similarly a component part fitted to a tank wall comprising a first part (68, 76, 78) of gasoline barrier material and a second part (72, 74) of weldable material, the first part includes at least partially an outer layer at portion 36 which is not enclosed by the second part. It would have been obvious to add a partial outer layer part to the component parts of Nulman, Suzuki

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(6305568) or Suzuki (JP 2001-113963) to allow the component part to attach to a conduit in a manner that doesn't leave a path for fuel vapor to escape.

Applicant's arguments filed March 26, 2007 have been fully considered but they are not persuasive. In response to comments made about Suzuki (6305568) or Suzuki (JP 2001-113963), the examiner has further explain that the abutting surface projects slightly beyond the first part. Furthermore, this limitation is moot since a final product is claimed with the second part welded to the fuel main body. In the configuration of the final product as shown by Fig. 1, for example, there is no projection slightly beyond the first part because both the first and second parts are flush. Only the intermediate product as shown by Fig. 5-7 includes a projection slightly beyond the first part. When the second part is welded, the material in the projection becomes part of the welded joint and is no longer considered the second part. The second part becomes flush with the first part as shown in Fig. 1.

New grounds of rejection have been made (1) new matter and 112, second paragraph rejections for claim 11-13 and 19 and (2) a 103 rejection for claim 18.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37


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CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Stephen J. Castellano whose telephone number is 571-272-4535. The examiner can normally be reached on increased flexibility plan (IFP).

The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.


Stephen J. Castellano
Primary Examiner
Art Unit 3781

sjc